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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,868	03/07/2002	Richard Gunacker	GK-CAS-105 / 500335.20005	4782
26418	7590	03/12/2004	EXAMINER	
REED SMITH, LLP ATTN: PATENT RECORDS DEPARTMENT 599 LEXINGTON AVENUE, 29TH FLOOR NEW YORK, NY 10022-7650			KIM, CHONG HWA	
			ART UNIT	PAPER NUMBER
			3682	

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/090,868

Applicant(s)

GUNACKER ET AL.

Examiner

Chong H. Kim

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 8-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

The Examiner acknowledges the applicant's Amendment filed Dec 18, 2003 in response to the Office action made on Jun 18, 2003.

#### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 8-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8 and 10-12 recite the language "particularly" in line 2 (also line 3 in claim 10). Such language is indefinite because it leads to confusion over the intended scope of a claim.

Claim 9 recites the limitation "the open-edged cutouts located opposite one another" in line 5. It is indefinite because claim 8 recites the cutouts being formed on one longitudinal edge and claim 9 appears to assume that there are cutouts formed on both sides. Furthermore, it is not clear what is "the minimum distance between the open-edges cutouts" when there is one longitudinal edge having the cutouts.

Claim 10 recites the limitation, "wherein the bottom plate of the plates that are placed one upon the other" in line 5. It is indefinite because it is not known what is "the other".

Claim 10 recites the limitation, "in the center thereof" in lines 7-8. It is indefinite because it is confusing as to which part of the elements the center is referring to.

Claim 10 recites the limitation, "said flow divider communicates,... with flow dividers which are arranged in another plate of the stack of plates that are placed one upon the other" in lines 9-11. It is indefinite because it is confusing.

Claim 10 recites the limitation, "wherein the plate having the additional flow dividers" in line 12. It is indefinite because it is not known what is the plate that has the additional flow dividers.

Claim 10 recites the limitations in lines 12-15 which include multiple function word "which" to introduce a relative clause. However, it is not clear which element the function word is referring to.

Claims 11-14 recite the limitation, "the other plate" in numerous places. It is indefinite because it is not known exactly what "the other plate" is referring to.

Claim 11-13 recite the limitation, "the plate" in numerous places. It is indefinite because it is not clear exactly which plate "the plate" is referring to.

(Note: since the claims are inundated with indefiniteness, no meaningful search could be done regarding the subject matters recited in claims 9, 12, and 13.)

### ***Claim Objections***

3. Claim 10 is objected to because of the following informalities: it is not clear whether claim 10 is an independent claim or a dependent claim. For this Office action, claim 10 has been treated to be an independent claim. Appropriate correction is required.

*Drawings*

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the depression (one) having holes (more than one) as recited in claim 11 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

*Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by S.E. Bates et al., U.S. Patent 1,880,672.

S.E. Bates et al. shows, in Figs. 1-7, a device for distributing lubricants in grooved rails (construed to be a grooved rail since, as broadly interpreted, there are two grooves formed below the rail head; and even if the grooves are not shown in the rail, the groove rails are not positively recited thus no patentable weight would have been given), particularly for railborne traffic, comprising;

an elongated plate 8 which can be arranged in the groove of the rail (since the language “can be” suggests a possibility) and which is provided with cutouts 14-20 at least along one longitudinal edge (not necessary on the top or bottom longitudinal edges, but the longitudinal edge on the side as broadly construed);

the cutouts starting at the longitudinal edge, the lubricant being supplied to these cutouts, and wherein the cutouts of the plate are covered by a cover plate 24 which is constructed so as to be elastic at least in the covering area;

7. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Stokes, U.S. Patent 2,907,410.

Stokes shows, in Figs. 1-5, an arrangement for feeding lubricants to the lubricant delivery openings, wherein the feed device has a plurality of plates which can be (since the language “can be” suggests a possibility) fixed in the groove of the rail (construed to be a grooved rail since, as broadly interpreted, there are two grooves formed below the rail head; and even if the grooves are not shown in the rail, the groove rails are not positively recited thus no patentable weight would have been given) one on top of the other as a stack (the word “top” is not construed in a sense of height but in relation to position in space to the source or beginning) ;

wherein the bottom plate 32 of the plates that are placed one upon the other is provided with a flow divider which is constructed as an elongated cutout in the plate;

wherein a feed opening 30 for the lubricant opens into the flow divider, in the center thereof;

the flow divider communicates, via at least two openings 44 which are at a distance from one another, with flow dividers 46 which are arranged in another plate 34 of the stack of plates that are placed one upon the other; and

wherein the plate having the additional flow dividers is followed in the stack by a plate 36 which communicates, via through openings 48, 50, with the flow divider or the flow dividers and which can also be connected to the lubricant delivery openings and which covers the flow divider or flow dividers of the plate.

*Claim Rejections - 35 USC § 103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore, U.S. Patent 2,173,654 in view of S.E. Bates et al., U.S. Patent 1,880,672.

Moore shows, in Figs. 1-8, a device for distributing lubricants in grooved rails, particularly for railborne traffic, comprising;

an elongated plate 1 which can be arranged in the groove of the rail and which is provided with cutouts 24 at least along one longitudinal edge;

the cutouts starting at the longitudinal edge, the lubricant being supplied to these cutouts;

but fails to show an elastic cover plate covering the elongated plate.

S.E. Bates et al. shows, in Figs. 1-7, a device for distributing lubricants for railborne traffic, comprising an elongated plate 8 having cutouts 17, wherein a cover plate 24 which is constructed so as to be elastic at least in the covering area covers the cutouts of the plate.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the lubricant distributing device of Moore by applying an elastic cover as taught by S.E. Bates et al. in order to protect parts that are inflexible so that the lubricating device would last longer.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stokes in view of S.E. Bates et al., U.S. Patent 1,880,672.

Stokes shows, as discussed above in the rejection of claim 10, the device comprising the flow dividers formed as holes, wherein the plate is covered on one side by a base 28, but fails to show the flow dividers formed as a depression with holes in the base of the depression.

S.E. Bates et al. shows, in Fig. 6, a flow divider 8 having a depression 20 with a hole 17 formed in the base of the depression.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the flow dividers of Stokes with the channeled flow dividers as taught by S.E. Bates et al. in order to provide a more effective lubricating device by enlarging the flow passage wherein a blockage due to foreign objects may be prevented.

11. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stokes.



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Stokes shows, as discussed above in the rejection of claim 10, the device comprising inlet port 30 but fails to show the port having male and female nipples for inlet/outlet connection.

The Examiner takes Official Notice the fact that such cone shaped nipple fittings as recited in claim 14 is well known in the fluid pipe connection art and such usage would have been within the level of ordinary skill in the art.

#### ***Response to Amendment***

12. The substitute specification filed Jul 1, 2002 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because: there is no statement regarding the new matter issues.

#### ***Response to Arguments***

13. Applicant's arguments, see Remarks, filed Dec 18, 2003, with respect to the rejection(s) of claim(s) 8 under 35 USC 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the newly found prior art as discussed above.

#### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rail having lubricant supply groove form on top of rail head.

McGarry, U.S. Patent 1,831,313

Brewer, U.S. Patent 764,108

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Humpheries et al., U.S. Patent 1,728,412

Blank, U.S. Patent 849,966

Clark, U.S. Patent 1,205,711

Lubricant flow dividers which can be arranged in grooves in rails.

Hamilton, U.S. Patent 1,810,764

Stern, U.S. Patent 1,918,146

Stern, U.S. Patent 2,016,975

Junk et al., U.S. Patent 5,394,958

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chong H. Kim whose telephone number is (703) 305-0922. The examiner can normally be reached on Tuesday - Friday; 8:00 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Bucci can be reached on (703) 308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

chk  
March 5, 2004

  
**CHONG H. KIM**  
**PRIMARY EXAMINER**